

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

EDWARD H. PHILLIPS,

Plaintiff-Appellant,

v.

AWH CORPORATION,
HOPEMAN BROTHERS, INC., and LOFTON CORPORATION,

Defendants-Cross Appellants.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF COLORADO IN CIVIL ACTION NO. 97-212,
JUDGE MARCIA S. KRIEGER

BRIEF OF *AMICI CURIAE* CONSUMERS UNION, ELECTRONIC
FRONTIER FOUNDATION, AND PUBLIC KNOWLEDGE IN SUPPORT
OF DEFENDANTS-CROSS-APPELLANTS

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September 20, 2004

CERTIFICATE OF INTEREST

Counsel for *Amici Curiae* Consumers Union, Electronic Frontier Foundation, and Public Knowledge certifies the following:

1. The full name of every party or *amicus curiae* represented by me is: Consumers Union; Electronic Frontier Foundation; and Public Knowledge.
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is: Consumer Union; Electronic Frontier Foundation; and Public Knowledge.
3. All parent corporations and any publicly held companies that own 10 percent of the stock of the party or *amicus curiae* represented by me are: None.
4. The names of all law firms and the partners or associates that appeared for the party or *amicus curiae* now represented by me in the trial court or are expected to appear in this court are:

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STATEMENT OF INTEREST OF AMICI

This brief is filed by the Consumers Union, the Electronic Frontier Foundation (EFF), and Public Knowledge (PK).¹

Consumers Union, publisher of *Consumer Reports* magazine, is a non-profit, independent testing and consumer-protection organization serving only consumers. Since 1936, Consumers Union has been a comprehensive source for unbiased reporting about goods, services, health, personal finance, and other consumer concerns. The organization is funded solely from sales of *Consumer Reports* and other services, and from nonrestrictive, noncommercial contributions, grants, and fees. Consumers Union engages regularly in consumer advocacy before the executive, judicial, and legislative branches of government. Consumers Union is committed to securing for consumers the innovation, competitive prices, range of choices, and product interoperability that result from an open marketplace, proper patent laws, and certainty regarding patent rights.

EFF is a nonprofit, membership-supported civil liberties organization working to protect consumer interests, innovation and free expression in the

¹ The Parties' Counsel have consented to filing of this brief. No part of this brief was authored by counsel for any party and no party, person, or organization contributed besides *amici* and their counsel. Nabila Isa-Odidi and Ramya Prakasam, students in the Glushko-Samuelson Intellectual Property Law Clinic, and Professor Davida Isaacs assisted in researching, drafting, and filing this brief.

digital world. EFF and its 15,000 dues-paying members have a strong interest in assisting the courts and policy-makers to strike the appropriate balance between intellectual property and the public interest. Increasingly, ambiguous (and otherwise invalid) patent claims are being asserted against community colleges, small website owners, non-profit institutions, and others. The threat of litigation chills these entities' internet-based educational and free-speech activities, particularly as these entities lack extensive legal resources and must rely on the public notice provided by clear patent claims. EFF believes it is critical for this Court to preserve the public benefit of clear notice and to protect non-traditional technology users from unfair patent infringement allegations.

PK is a non-profit advocacy and education organization promoting a balanced approach to intellectual property law and technology policy reflecting the "cultural bargain" intended by the framers of the U.S. Constitution. PK works to promote fundamental democratic principles and cultural values of openness, access, and the capacity to create and compete. PK advocates for patent policies and laws that encourage innovation, creativity, and competition.

SUMMARY OF ARGUMENT

Question 5 posed by this Court asked “[w]hen, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity”? Under binding Supreme Court precedent, claims must be sufficiently definite for the public to determine their meaning without litigation. Claim language thus must avoid ambiguities that would oblige courts to impose a definite meaning either to preserve validity or to assure protection.

Until 2001, this Court required claims to have an understandable scope when viewed by skilled artisans. Since 2001, however, panels of this Court have found claims to be valid so long as they are not “insolubly ambiguous.” This revised definiteness standard unjustifiably authorizes and encourages judges to impose a meaning on ambiguous claims.

This Court should strictly enforce the stringent definiteness standard. Judges should invalidate and Patent Office examiners should reject ambiguous claims. Obliging applicants to clarify their claims will minimize litigation and will promote innovation and competition. This Court also should clarify the “correct principles” of claim construction. Skilled artisans should view claim terms according to their broadest reasonable meaning before issuance and their narrowest reasonable meaning thereafter. These correct principles will protect the public and preserve patentees’ rights.

ARGUMENT

This Court is acutely aware of the need to minimize the social costs and administrative burdens of resolving patent scope through litigation. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 575 (Fed. Cir. 2000) (en banc) (the notice function “has become paramount and the need for certainty as to the scope of patent protection has been emphasized”). These costs and burdens are mounting, as larger numbers of invalid patents issue, more patents are litigated and licensed, and patents increasingly deter anti-competitive litigation threats rather than protect innovations.² More than ever before, individuals and organizations lacking the resources to litigate need protection from ambiguous patent claims that tax innovation and deter competition. This Court can provide such protection, by assuring that patent claims issue and are enforced only when

² *See generally* Federal Trade Comm’n, *To Promote Innovation: The Proper Balance of Competition and Patent Law* (Oct. 2003), available at <http://www.ftc.gov/reports/index.htm> (hereinafter “*FTC Report*”); James Bessen & Michael J. Meurer, *The Patent Litigation Explosion*, available at <http://www.bu.edu/law/news/ip/papers/lit.pdf>, last visited Sept. 16, 2004; Michael J. Meurer, *Controlling Opportunistic and Anti-Competitive Intellectual Property Litigation*, 44 *Boston College L. Rev.* 509-544 (2003); John R. Allison, *et al.*, *Valuable Patents* (July 2003), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=426020; Wesley M. Cohen, *et al.*, *Protecting Their Intellectual Assets: Appropriability Conditions and why U.S. Manufacturing Firms Patent (or not)* (Feb. 2000), available at <http://papersdev.nber.org/papers/W7552>.

those claims are so unambiguous that skilled artisans can identify their scope without litigation. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) (a “zone of uncertainty...would discourage invention only a little less than unequivocal foreclosure of the field”) (*quoting United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)).

The most important rule of patent law is the standard for determining whether claims satisfy the “distinct claiming” requirement. 35 U.S.C. §112, ¶2 (2000). Binding precedent establishes that patent claims must be sufficiently clear to distinguish the invention from prior public knowledge and to identify the limits of protection sought and obtained. This standard prohibits ambiguous claims that oblige judges in particular cases to impose a narrower or broader meaning in order to determine validity or infringement. This Court’s recent “insolubly ambiguous” standard for definiteness departs from the historic standard and encourages judges to impose rather than to find meaning. Instead, courts and the Patent Office should strictly enforce the distinct claiming requirement by invalidating and rejecting ambiguous claims. To minimize ambiguities and to avoid circularity, this Court also should clarify the “correct principles” for construction with which skilled artisans (and thus judges and examiners) view claims. But this Court not shoulder the patentee’s burden of resolving ambiguity of specific claims.

I. Binding Precedent Prohibits Claim Ambiguities That Can Be Resolved Only By Imposing A Meaning In Litigation.

The Patent Act and Supreme Court precedent require claims to be sufficiently definite for courts and the public to discern claim meaning. The distinct claiming requirement of Section 112, Second Paragraph derives from *Evans v. Eaton*, where the Court obliged applicants to “explain what is the nature or limit of the improvement ... claim[ed] as his own.” 20 U.S. (7 Wheat.) 356, 434 (1822). Clear claiming language was required “to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented.” *Id.* Following *Evans*, Congress obliged patentees to identify the limits of their claimed inventions, first “particularly” and later “distinctly.” Act of July 4, 1836, ch. 357, § 6, 5 Stat. 117, 119; Act of July 8, 1870, ch. 230, § 26, 16 Stat. 198, 201.

Cases contemporary to *Evans* held patents invalid if they did not readily and unambiguously identify the limits of the claimed invention. *See, e.g., Lowell v. Lewis*, 15 F. Cas. 1018, 1020 (C.C.D. Mass. 1817) (unless the description “distinctly ascertain[s] for which [scope] the patent is claimed, it must be void” and what is claimed must “appear with reasonable certainty on the face of the patent, either expressly or by necessary implication”). Imposing a meaning on ambiguous claims in litigation was improper, because it required assessments that judges – and even skilled artisans –

were incompetent to make. *See, e.g., id.* at 1020 (“if not intended to cover the whole, it is impossible for the court to say, what, in particular, is covered as a new invention”); *Isaacs v. Cooper*, 13 F. Cas. 153, 154 (C.C.D. Pa. 1821) (unless the inventor clearly distinguishes the protected invention in the patent, how “can any human being, however skillful in the art, find out, with certainty, or even conjecture, in what the improvement consists”).

A decade before the 1952 Patent Act, the Supreme Court reaffirmed this stringent definiteness standard:

The inventor must “inform the public ... of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.”... The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.

United Carbon, 317 U.S. at 232, 236 (quoting *General Electric Co. v. Wabash Corp.*, 304 U.S. 364, 369 (1938)). Further, “the claims must be reasonably clear-cut to enable courts to determine whether novelty and invention are genuine.” *Id.* at 236.

In *United Carbon*, the Court held invalid for indefiniteness a claim for a narrow improvement invention that employed functional language at the point of novelty. *See id.* at 237. *See also Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 8 (1946). In the 1952 Patent Act, Congress

reversed the specific holdings of *General Electric*, *United Carbon*, and *Halliburton* that had prohibited use of such functional claiming language. *See* 35 U.S.C. § 112, ¶6 (2000). But Congress also recodified the “distinct claiming” requirement of the 1870 Patent Act and did not otherwise alter the Court’s standard for determining when claim language is sufficiently clear. *See, e.g.*, S. Rep. No. 82-1979, at 19 (1952) (accompanying H.R. 7794) (noting limited changes to Rev. Stat. § 4888 codified at 35 U.S.C. § 33 (1940)); Ronald D. Hantman, *Patent Infringement*, 72 J. Pat. & Trademark Off. Soc’y 454, 486-88 (1990); Karl B. Lutz, *The New 1952 Patent Statute*, 35 J. Pat. & Trademark Off. Soc’y 155, 161 (1953). *Cf. Rengo Co. v. Molins Machine Co.*, 657 F.2d 535, 551 (Fed. Cir. 1981) (a “relaxed standard” applies to functional claiming language).

Recently, when promoting uniformity of patent claim construction determinations in *Markman*, the Supreme Court reiterated the need for clarity of claims. *See* 517 U.S. at 390 (*citing General Electric, United Carbon, and Merrill v. Yeomans*, 94 U.S. 568 (4 Otto) 568 (1876)). In particular, the Court warned against a “zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims” and stressed the need to avoid depriving the public “of rights supposed to belong to it, without being clearly told what it is that limits these rights.”

Id. (quoting *United Carbon*, 317 U.S. at 236, and *Merill*, 94 U.S. (4 Otto) at 573). Similarly, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, the Court recognized that clarity of patents is “essential to promote progress” and that a “patent holder should know what he owns, and the public should know what he does not.” 535 U.S. 722, 730-31 (2002).

Under the Supreme Court’s definiteness standard, claims must be sufficiently clear to permit courts to determine whether they are valid and whether they apply. Courts may not supply a narrowing construction in order to preserve the validity of an ambiguous claim. Nor should courts supply a broadening construction to provide patentees with greater protection. *See United States v. Adams*, 383 U.S. 39, 48-49 (1966) (“the claims of a patent limit the invention, and the specifications cannot be utilized to expand the patent monopoly”). To do so would prevent the very determinations that the courts are supposed to make, based on the meaning that skilled artisans reading the claims would attach to the claims.

Dicta from Supreme Court cases might be cited to support judicial efforts to impose a narrow or broader construction on ambiguous claims, particularly for pioneering inventions.³ These cases do not support the

³ *See, e.g., Smith v. Snow*, 294 U.S. 1, 14 (1935) (citing *Keystone Mfg. Co. v. Adams*, 151 U.S. 139, 144 (1894), and *McClain v. Ortmyer*, 141 U.S. 419, 425 (1891)); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261

proposition,⁴ but if they did they could not be reconciled with *United Carbon*. As the Court has recognized, if judges may supply limitations to preserve validity, “we should never know where to stop.” *McCarty v. Lehigh Valley RR Co.*, 160 U.S. 110, 116 (1895). This is no less true if the limitations are supplied by imposing a meaning on ambiguous claim

U.S. 45, 63 (1923); *Sessions v. Romadka*, 145 U.S. 29, 45 (1892); *Klein v. Russell*, 86 U.S. (19 Wall.) 433, 466 (1873); *Turrill v. Michigan Southern & Northern Indiana RR*, 68 U.S. (1 Wall.) 491, 510 (1863).

⁴ Pioneering inventions are entitled to broad scope only because the absence of relevant prior art allows broad claims that block later (even patentable) improvements. *See, e.g., Sessions*, 145 U.S. at 31, 42-45. But breadth is not ambiguity. These cases did not involve ambiguities preventing skilled artisans from understanding the claims or requiring courts to impose meanings. In *Smith*, the Court stated that examination of the claim “in light ... of the scientific fact ... makes it plain” that the claim was not restricted. 294 U.S. at 14. *See also id.* at 14-15 (characterizing the prosecution history). In *Eibel*, the Court noted that “indefiniteness is objectionable, because the patent does not disclose ... how its infringement may be avoided”; skilled artisans “had no difficulty” determining the scope of the claims. 261 U.S. at 65. In *Keystone*, when addressing novelty, the Court illogically suggested that a narrowing construction would have been “fatal to the grant.” 141 U.S. at 145. In *McClain*, the Court recognized that “[w]hen the terms of a claim in a patent are clear and distinct, (as they always should be,) the patentee ... is bound by it.” 141 U.S. 424, 425 (quoting *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. (5 Otto) 274, 278 (1877)). In *Klein*, the Court addressed a patent reissued just prior to the 1870 Patent Act’s distinct claiming requirement; the “original specification and claim were clearly confined,” and thus any broader construction was precluded for reissue. 86 U.S. (19 Wall.) at 466. In *Turrill*, the restricted construction was “quite clear” in view of the specification. *Id.* at 511.

language than by adding language to the claims. The same restriction on imposing meaning applies to broadening claims to assure protection.⁵

II. This Court’s Recent “Insolubly Ambiguous” Standard Of Definiteness Conflicts With Binding Precedent And Is Unjustified.

This Court historically required claims to have a distinctive meaning that provides the public with readily determined notice and that precludes judges from imposing a meaning in litigation. The definiteness standard required that “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470 (Fed. Cir. 1993) (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). See *Hogenas AB v. Dresser Industries, Inc.*, 9 F.3d 948, 951(Fed. Cir. 1993).⁶ “The requirement essentially demands precision in the

⁵ See, e.g., *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886) (claims may not be enlarged by argument); *Western Elec. Mfg. Co. v. Ansonia Brass & Copper Co.*, 114 U.S. 447, 453 (1885) (claims may not be enlarged by reference to the specification) (citing *Lehigh Valley RR Co. v. Mellon*, 104 U.S. (14 Otto) 112, 118 (1881)); *Miller v. Bridgeport Brass Co.*, 104 U.S. (14 Otto) 350, 352 (1881) (omission from claims dedicates the disclosed subject matter to the public); *Bates v. Coe*, 98 U.S. (8 Otto) 31, 38 (1878) (patentees are limited to their claims even when their inventions are larger).

⁶ This Court’s predecessor adopted a similar standard, emphasizing the ability to determine claim scope without speculation. See *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962) (discussing Patent Office “speculations and assumptions” regarding ambiguity that the Court could not resolve).

language of the claim.” *Rengo*, 657 F.2d at 551. *See id.* (definiteness “provide[s] notice to others of the limits ‘beyond which experimentation and invention are undertaken at the risk of infringement’”) (citation omitted). The Court in *Morton* thus held invalid a claim that was “not sufficiently precise to permit a potential competitor to determine [without litigation] whether or not he is infringing.” 5 F.3d at 1470.

In *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371 (Fed. Cir. 2001), a panel of this Court altered this definiteness standard. The panel stated that claims are indefinite only if “insolubly ambiguous, and no narrowing construction can properly be adopted.” *Id.* at 1375. *But cf. id.* (claims are indefinite “only if reasonable efforts at claim construction prove futile”). The “insolubly ambiguous” standard improperly encourages judges to apply and to approve of heroic efforts to impose meanings on claims that are ambiguous when viewed by skilled artisans. *See, e.g., Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1373-74 (Fed. Cir. 2004) (construing ambiguous term by equating it to another term, while acknowledging that “[t]he patent uses the two terms in slightly different ways” and reflects “poor drafting practice”); *Metabolite Labs., Inc. v. Lab. Corp. of America Holdings*, 370 F.3d 1354, 1366 (Fed.

Cir. 2004) (upholding claim validity because the trial court had “produced” a discernible meaning).

The panel in *Exxon* based the new definiteness standard on a false and unpalatable choice of alternatives: requiring claims to be “plain on their face in order to avoid condemnation for indefiniteness”; or forcing courts to “discern” a meaning for claims “even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree.” *Id.* at 1375 (citing *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1557 (Fed. Cir. 1996), and *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996)). This Court’s historic standard, however, provided an intermediate position. Claim language may require interpretation,⁷ but claim limits must be discernible without imposing a meaning in litigation.

The two cases relied upon in *Exxon* also did not support the new standard. The first case held that technical terms “are not *per se* indefinite

⁷ See, e.g., *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 33 (1966) (claims “must be read and interpreted with reference to rejected ones and to the state of the prior art”); *Webster Loom Co. v. Higgins*, 105 U.S. (15 Otto) 580, 586 (1881) (courts may consider extrinsic evidence “to understand the terms used in the patent and the devices and operations described or alluded to therein”); *Bates*, 98 U.S. (8 Otto) at 38 (courts may refer to specifications “in case of doubt or ambiguity”); *Autogiro Co. of America v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967) (“a claim cannot be interpreted without going beyond the claim itself”).

when expressed in qualitative terms without numerical limits.” *Modine*, 75 F.3d at 1557. *Modine* also contains dicta that claims “amenable to more than one construction” should “when reasonably possible be interpreted so as to preserve their validity” and that ““if the language is as precise as the subject matter permits, the courts can demand no more.”” *Id.* (quoting *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985) and citing *Whittaker Corp. by its Technibilt Div. v. UNR Indus., Inc.*, 911 F.2d 709, 711 (Fed. Cir. 1990), and *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984), for preserving the validity of ambiguous claims). *Modine*’s dicta are not supportable, because they were based (ultimately) on Supreme Court dicta in cases that were decided or addressed patents issued before the distinct claiming requirement and that did not involve ambiguity. See *Whittaker*, 911 F.2d at 712 (citing *ACH Hospital Systems*, 732 F.2d at 1577); *ACS Hospital Systems*, 732 F.2d at 1577 (citing *Klein*, 86 U.S. (19 Wall) at 466, *Turrill*, 68 U.S. (1 Wall) at 510, and *Carmen Indus., Inc. v. Wahl*, 724 F.2d 932, 937 n.5 (Fed. Cir. 1983) (also citing *Klein* and *Turrill*)).

The second case relied upon in *Exxon* did not directly address indefiniteness. See *Athletic Alternatives*, 73 F.3d at 1577 n.4, 1581. Rather, the Court in *Athletic Alternatives* relied on the definiteness standard for

policy guidance when interpreting specific claims to determine infringement. In that context, the Court cited *Rengo* and *Hogenas* for the relevant definiteness standard and recognized that a broad construction would defeat public notice. *See id.* at 1581. The majority’s approach, however, conflated narrowness and definiteness and “eviscerate[d] the requirement ... to ... distinctly claim [the] invention while purporting to rely on it.” *Id.* at 1583 (Nies, J., concurring).

The panel in *Exxon* also sought to justify its new insolubly ambiguous standard as respecting “the statutory presumption of patent validity” and as protecting “the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.” 265 F.3d at 1375. The presumption of validity, however, addresses only the burden of proof and the evidentiary showing required to establish invalidity. *See Magnivision, Inc. v. Bonneau Co.*, 115 F.3d 956, 958 (Fed. Cir. 1997). The presumption does not address the legal standard that must be applied to assessing definiteness, which relates to claim construction and thus is a question of law subject to *de novo* review. *See, e.g., Amtel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999) (*citing Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc)). The distinct claiming requirement, moreover, places the burden on applicants to draft clear claims,

not on the courts to impose limits on ambiguous claims. *See Festo*, 535 U.S. at 735 (applicants are bound by their claiming decisions when they “knew the words ... and affirmatively chose” the scope of protection); *United Carbon*, 317 U.S. at 233 (“To sustain claims so indefinite ... would be in direct contravention of the public interest which Congress therein recognized and sought to protect.”).

The relevant Supreme Court precedent has existed undisturbed for over a century and is binding on this Court. This Court’s insolubly ambiguous standard has existed for three years, conflicts with circuit precedent, has not been adopted *en banc*, and is not yet official Patent Office policy.⁸ This Court should repudiate the insolubly ambiguous standard without any concern that it would impose a retroactive change to the law. *See Festo*, 535 U.S. at 739 (“Fundamental alterations in these rules risk destroying the legitimate expectations of inventors in their property”). *Cf. Johnson & Johnson Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1064 (Fed. Cir. 2002) (Newman, J., dissenting) (“we have no authority to change the precedent that binds us”).⁹

⁸ *See Manual of Patent Examining Procedure*, § 2173.02, 2100-205 to 2100-206 (8th ed. 2d rev. 2004) (hereinafter “MPEP”) (citing this Court’s earlier definiteness standard).

⁹ Patentees could have relied on the insolubly ambiguous standard, moreover, only for applications filed or prosecutions continued after the

III. This Court Should Invalidate Ambiguous Claims And Should Impose “Correct Principles” of Construction That Protect The Public.

Question 5 asks whether judges should construe claims narrowly to preserve validity. The question assumes a mistaken premise. Judges cannot choose to impose a narrow meaning on claims, because the distinct claiming requirement prohibits ambiguous claims. The question is not what the claims should be for judges, but rather what they are for skilled artisans: broad, narrow, or invalidly ambiguous.

This Court should clearly state and should strictly enforce the requirement that judges must invalidate rather than impose a meaning on ambiguous claims. At various times this Court has suggested that judges should impose a meaning on specific claims having different degrees or kinds of ambiguity, *e.g.*, less-than-insoluble ambiguity, as much precision as possible given the invention, etc. *See, e.g., Exxon*, 265 F.3d at 1375; *Shatterproof Glass Corp.*, 758 F.2d at 624. But binding precedent prohibits all such ambiguities that cannot be resolved without resort to litigation. *See United Carbon*, 317 U.S. at 237 (“An invention must be capable of accurate definition, and it must be accurately defined, to be patentable”).

Exxon decision, in which claims knowingly were not amended to be more definite (so as to protect against potential future invalidation by the courts). Even if there were patentees who so relied, they could correct their errors in judgment by seeking a narrowing reissuance to clarify their claims and thereby preserve their rights. *See* 35 U.S.C. § 251 (2000).

The Patent Office also should strictly enforce the definiteness standard, rejecting ambiguous claims rather than imposing a meaning to assess validity. No presumption of validity should apply to or deference should be accorded Patent Office definiteness determinations, particularly as definiteness is a legal conclusion and not a factual judgment. *See, e.g., FTC Report*, ES8-ES10 (the “strong presumption of a patent’s validity is inappropriate” and should be revised by legislation); *Amtel*, 198 F.3d at 1378 (“indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims”) (citation omitted). Although Patent Office policy recites application of the proper definiteness standard, it does not currently encourage examiners to rigorously apply it. *See MPEP* § 2173.02 at 2100-205 (encouraging examiners to permit “some latitude in the manner of expression and the aptness of terms” and noting that rejection of indefinite claims only “would be appropriate” rather than is required).

Commentators have urged the Patent Office to oblige applicants to clarify the meaning of ambiguous claim terms during prosecution, focusing on selecting and limiting dictionary references. *See, e.g., Joseph S. Miller & James A. Hilsenteger, The Proven Key: Roles & Rules for Dictionaries at the Patent Office and the Courts* 54-60 (Aug. 16, 2004), available at

http://papers.ssrn.com/sol3/papers.cfm?abstract_id=577262. These commentators estimate that shifting the resolution of claim ambiguities from litigation in the courts to prosecution in the Patent Office would likely result in multi-million-dollar net savings of governmental and private legal expenditures. Even greater social benefits would likely result from avoiding the opportunity costs of foregone innovation and of decreased competition in the marketplace that result from ambiguous claims. *See id.* at 56-58.

Strictly enforcing the stringent definiteness standard in the courts and the Patent Office will not lead to invalidation of all existing patents or to rejection of all future patent claims. Language is routinely understood to have a discernible meaning when addressed to particular audiences, such as skilled artisans. *See generally* Stanley Fish, *Is There a Text in this Class? The Authority of Interpretive Communities* (1980). Moreover, whether claims have a discernible meaning to persons of ordinary skill in the art circularly depends on (or at least is affected by) the “correct principles” for claim construction that are adopted by the courts. *Metabolite*, 370 F.3d at 1366. By clarifying the correct principles, this Court will minimize ambiguities of meaning to skilled artisans and thus will better assure that specific claims will have a discernible meaning without resort to litigation.

Any approach to claim construction that is clear, uniform, and consistently applied thus is preferable to the current situation, by providing greater certainty to the patent system and by promoting fairness for patentees and the public (who can conform their conduct accordingly). Nevertheless, the choice of principles matters.

This Court should strive to effectuate the public notice function of claims. Before issuance, skilled artisans (and by extension the Patent Office) should be obliged to view claim terms according to their broadest reasonable meaning in the art. This will best assure that claim language is clarified during prosecution to avoid ambiguities and that the scope of claims that issue are justified in light of prior art. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Requiring the broadest reasonable construction prior to issuance also protects the public’s constitutional right to retain intellectual property it already owns. *See Graham*, 383 U.S. at 6 (prohibiting removal of “existent knowledge from the public domain, or ... restrict[ion of] free access to materials already available”).

After issuance, skilled artisans (and by extension judges) should be obliged to view claim terms according to their narrowest reasonable meaning in the art. Judges thus should apply the same narrow construction

for both infringement and validity. *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (similar constructions are “axiomatic”). This narrow approach to construction will best assure that public notice is provided and will best preserve the validity of issued claims, upholding the rights of both patentees and the public. *See, e.g., Athletic Alternatives*, 73 F.3d at 1581 (“we consider the notice function of the claim to be best served by adopting the narrower meaning”). Further, the patentee is the master of the claims. Knowing that claims will be construed narrowly after issuance, patentees can choose broader but clearer terms to protect the full scope of their inventions. This Court should therefore explicitly repudiate (for post-issuance construction) the approach it adopted in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, which provides that ambiguous claim terms “encompass all ... consistent [dictionary] meanings.” 308 F.3d 1193, 1203 (Fed. Cir. 2002). *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1343 (Fed. Cir. 2001).

CONCLUSION

Requiring applicants to clearly state what they mean to protect is both efficient and fair. It also has been the law at least since the 1870 Patent Act.

The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions.... [N]othing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.

Merrill, 94 U.S. (4 Otto) at 573-74.

Respectfully Submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure, I certify that the foregoing Brief of *Amici Curiae* Consumers Union, Electronic Frontier Foundation, and Public Knowledge is double-spaced (except headings, block quotations, and footnotes) and complies with the type volume limitations of Rule 29(d) of the U.S. Court of Appeals for the Federal Circuit and this Court's July 21, 2004 Order. I further certify that the body of this brief -- not including the cover page, table of contents, table of authorities, and certificates -- contains 4995 words as determined by Microsoft Word, including the statement of interest, headings, footnotes, quotations, signature lines, and date.

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CERTIFICATE OF SERVICE

I, Joshua D. Sarnoff, hereby certify that I caused two copies of the foregoing Brief of *Amici Curiae* Consumers Union, Electronic Frontier Foundation, and Public Knowledge to be served this twentieth (20th) day of September 2004, by first class mail, postage prepaid, upon each of the following sets of Counsel of Record:

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